Paper No. 67

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI SHIRAGAMI,
YASUO IRIE, and NAOHIKO YASUDA

Appeal No. 1997-0481
Application No. 08/161,071

ON BRIEF

Before WINTERS, ROBINSON, and ADAMS, Administrative Patent Judges.

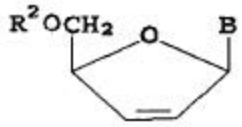
ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 19, 20, 23, and 24, which are all the claims pending in the application.

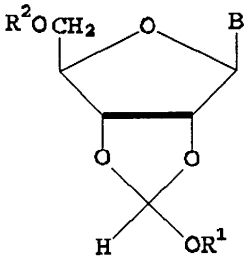
Claim 19 is illustrative of the subject matter on appeal and is reproduced below:

19. A process for obtaining a 2',3'-dideoxy-2',3'-didehydronucleoside of formula (VIII):



(VIII)

wherein B is an unsubstituted or 5-substituted uracil residue bound at its 1-position, and R^2 is a hydrogen atom, an acyl group, an aralkyl group, or a silyl group, said process comprising reacting, with an acid anhydride, a nucleoside derivative of formula (VII):



(VII)

wherein R^1 is an alkyl group having 1 to 12 carbon atoms and B is identical to the uracil residue of formula (VIII).

The reference relied upon by the examiner is:

Eastwood et al. (Eastwood), "The Conversion of 2-Dimethylamino-1, 3-Dioxolans into Alkenes," Tetrahedron Letters, Vol. 60, pp. 5223-224 (1970)

GROUND OF REJECTION

Claims 19, 20, 23, and 24 are rejected under 35 U.S.C. § 103 as obvious over Eastwood.

We reverse.

DISCUSSION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, and to the respective positions articulated by the appellants and the examiner. We make reference to the Examiner's Answer[1] for the examiner's reasoning in support of the rejection. We further reference appellants' Brief[2] for the appellants' arguments in favor of patentability. We note the examiner's communication[3] denying entry of appellants' Reply Brief[4], appellants did not petition for entry of the Reply Brief. Accordingly, we will not consider the Reply Brief.

We also note appellants' Request for Oral Hearing[5] and appellants' Confirmation of Oral Hearing[6]. In the Confirmation of Oral Hearing, appellants'

[1] Paper No. 61, mailed March 7, 1996.
[2] Paper No. 60, received December 1, 1995.
[3] Paper No. 64, mailed July 31, 1996.
[4] Paper No. 63, received May 2, 1996.
[5] Paper No. 62, received May 2, 1996.

representative states "undersigned counsel represents he will personally appear on October 10, 2000, at 9:00 a.m., to present oral arguments." This panel convened at 9:00 a.m. on October 10, 2000 to hear appellants' oral argument, however, appellants' representative did not appear for this hearing. Accordingly, our decision is based on appellants' Brief.

THE REJECTION UNDER 35 U.S.C. § 103:

The initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The examiner states (Answer, page 3) that "[i]t would have been obvious to one of ordinary skill in the art to have used the reaction method described by Eastwood et al. to obtain the 2', 3'- dideoxy-2', 3'-didehydronucleoside of the instant invention." We note that the Eastwood reference makes no mention of the specific uracil compounds claimed by appellants. Thus, it appears that while not expressly citing the authority, the examiner rests her prima facie case of obviousness on In re Durden, 763 F.2d 1406, 1410, 226 USPQ 359, 361 (Fed. Cir. 1985).

These facts are similar to those found in In re Ochiai, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1996). The Ochiai court summarized the Board's position that

> [w]e are not here concerned with the patentability of the starting materials, the final compounds or other processes of

[6] Paper No. 66, received July 11, 2000.

> making the [cephem] compounds. We are concerned only with the claimed process and the patentability thereof. Cases such as In re Larsen, 292 F.2d 531, 130 USPQ 209 (CCPA 1961); In re Albertson, 332 F.2d 379, 141 USPQ 730 (CPA 1964) and, particularly, In re Durden …all of which were directed to processes of making chemical compounds, are controlling herein… [modification original].

Ochiai, 71 F.3d at 1568, 37 USPQ2d at 1130.

However, the court stated in Ochiai, 71 F.3d at 1572, 37 USPQ2d at 1133:

> [A]s we clearly indicated in In re Dillon, a recent in banc decision, '[w]hen any applicant properly presents and argues suitable method claims, they should be examined in light of all … relevant factors, free from any presumed controlling effect of Durden' or any other precedent. 919 F.2d 688, 695, 16 USPQ2d 1897, 1903 (Fed. Cir. 1990)(in banc), cert. denied, 500 U.S. 904 (1991).

In this case, the present claims are not directed to the process of reacting 2-alkoxy-1,3-dioxolans with an acid anhydride, as taught by the reference. Rather, the claims are directed to a process involving uracil derivatives.

Therefore, having compared appellants' claims, limited as they are to the use of a particular nonobvious starting material for making a particular nonobvious end product, to the prior art of record, we reverse the rejection of claims 19, 20, 23, and 24 as an incorrect conclusion reached by incorrect methodology. Compare, Ochiai, 71 F.3d at 1572, 37 USPQ2d at 1133.

Having determined that the examiner has not established a prima facie case of obviousness, we find it unnecessary to discuss the Shiragami[7] reference and corresponding unexpected results, the Ineyama Declaration executed July

[7] Shiragami et al. (Shiragami), "Synthesis of 2', 3'-Dideoxyuridine via deoxygenation of 2',3'-O-(methoxymethylene)uridine," J. Org. Chem., Vol. 53, pp. 5170-173 (1988).

19, 1993, or the Ineyama Declaration executed August 9, 1994, all relied on by appellants to rebut any such prima facie case.

REVERSED

Sherman D. Winters	)
Administrative Patent Judge	)
	)
	) BOARD OF PATENT
Douglas W. Robinson	)
Administrative Patent Judge	) APPEALS AND
	) INTERFERENCES
Donald E. Adams	)
Administrative Patent Judge	)

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